

**REMARKS**

The Office Action mailed March 7, 2007, has been received and reviewed. Claims 1 through 27 are currently pending in the application. Claims 10 through 27 are withdrawn from consideration as being drawn to a non-elected invention. Claims 1 through 4 and 7 through 9 stand rejected. Claims 5 and 6 have been objected to as being dependent upon rejected base claims, but the indication of allowable subject matter in such claims is noted with appreciation. Applicants have amended claims 1, 5, and 6, and respectfully request reconsideration of the application as amended herein.

**35 U.S.C. § 102(b) Anticipation Rejections**

**Anticipation Rejection Based on U.S. Patent No. 6,474,778 to Koitabashi et al.**

Claims 1 and 2 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Koitabashi et al. (U.S. Patent No. 6,474,778) (hereinafter "Koitabashi"). Applicants respectfully traverse this rejection, as hereinafter set forth.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

A method for printing a pattern on a medium, the method comprising: assigning a pattern to a medium, wherein the pattern defines coordinates of a portion of the medium; applying a fixer to the portion of the medium in the pattern; and applying an ink to a portion of the medium not having fixer. As illustrated in Fig. 4 of Koitabashi, color ink and black ink are both applied to a print medium, and a processing liquid is applied on the color ink and black ink throughout multiple portions of the print medium. As discussed in paragraph [0043] of the present application, the fixer by itself is visible only where no pigmented ink is present. Thus, the description of the combined ink and processing liquid of Koitabashi does not describe each and every element of claims 1 and 2.

As such, applicants respectfully request reconsideration and withdrawal of the present rejection.

### 35 U.S.C. § 103(a) Obviousness Rejections

Obviousness Rejection Based on Koitabashi in view of U.S. Patent No. 6,158,834 to Kato et al.

Claims 3 and 4 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Koitabashi in view of Kato et al. (U.S. Patent No. 6,158,834) (hereinafter “Kato”).

Applicants respectfully traverse this rejection, as hereinafter set forth.

M.P.E.P. 706.02(j) sets forth the standard for a Section 103(a) rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (Emphasis added).

The 35 U.S.C. § 103(a) obviousness rejections of claims 3 and 4 are improper because the combined references do not teach each and every element of the claims.

As previously discussed, independent claim 1 requires, in part, applying a fixer to the portion of the medium in the pattern and applying an ink to a portion of the medium not having fixer. As illustrated in Fig. 4 of Koitabashi, color ink and black ink are both applied to a print medium, and a processing liquid is applied on the color ink and black ink throughout multiple portions of the print medium. As discussed in paragraph [0043] of the present application, the fixer by itself is visible only where no pigmented ink is present. Thus, the description of the combined ink and processing liquid of Koitabashi does not describe each and every element of claims 1 and 2, from which claims 3 and 4 depend.

Kato et al. is relied upon as teaching application of a fixer to a medium before and after applying the ink to the medium. However, Kato et al. does not overcome the deficiencies of Koitabashi relative to the limitations in independent claim 1.

As such, applicants respectfully request reconsideration and withdrawal of the present rejection.

Obviousness Rejection Based on Koitabashi in view of U.S. Patent No. 6,134,025 to Takeuchi et al.

Claim 7 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Koitabashi in view of Takeuchi et al. (U.S. Patent No. 6,134,025) (hereinafter "Takeuchi"). Applicants respectfully traverse this rejection, as hereinafter set forth.

Claim 7 depends from claim 2, which in turn depends from claim 1. Koitabashi includes the teachings described above with reference to the previous rejection. Takeuchi is relied upon as teaching 1-bit plane of image data. However, Takeuchi does not overcome the deficiencies of Koitabashi relative to the limitations in independent claim 1.

As such, applicants respectfully request reconsideration and withdrawal of the present rejection.

Obviousness Rejection Based on Koitabashi in view of U.S. Patent No. 6,378,978 to Byers et al.

Claims 8 and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Koitabashi in view of Byers et al. (U.S. Patent No. 6,378,976) (hereinafter "Byers"). Applicants respectfully traverse this rejection, as hereinafter set forth.

Claims 8 and 9 depend from claim 2, which in turn depends from claim 1. Koitabashi includes the teachings described above. Byers is relied upon as teaching configuring software associated with a computer and configuring firmware to prepare the image of the layout of the document for printing. However, Byers does not overcome the deficiencies of Koitabashi relative to the limitations in independent claim 1.

As such, applicants respectfully request reconsideration and withdrawal of the present rejection.

**Objections to Claims 5 and 6/Allowable Subject Matter**

Claims 5 and 6 stand objected to as being dependent upon rejected base claims, but are indicated to contain allowable subject matter and would be allowable if placed in appropriate independent form. Claims 5 and 6 have been amended to place the same in independent form. As such, applicants respectfully submit that the objections have been overcome.

**ENTRY OF AMENDMENTS**

The amendments to claims 1, 5, and 6 above should be entered by the Examiner because the amendments are supported by the as-filed specification and drawings and do not add any new matter to the application. Further, the amendments do not raise new issues or require a further search.

**CONCLUSION**

Claims 1-9 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, he is respectfully invited to contact Applicants' undersigned attorney.

Respectfully submitted,



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